

Docket No. 04-102

Patent

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: URS (NMI) REUTELER ET AL. : Confirmation No.: 5960
Serial No.: 10/532,528 : Group Art Unit: 3721
Filed: October 7, 2005 : Examining Attorney: Christopher Harmon
For: **CARTON FEEDING AND FORMING MACHINE WITH SELECTIVELY
ACTUATED LUGS AND RELATED METHODS**

PRE-APPEAL REQUEST FOR REVIEW

Dear Sir:

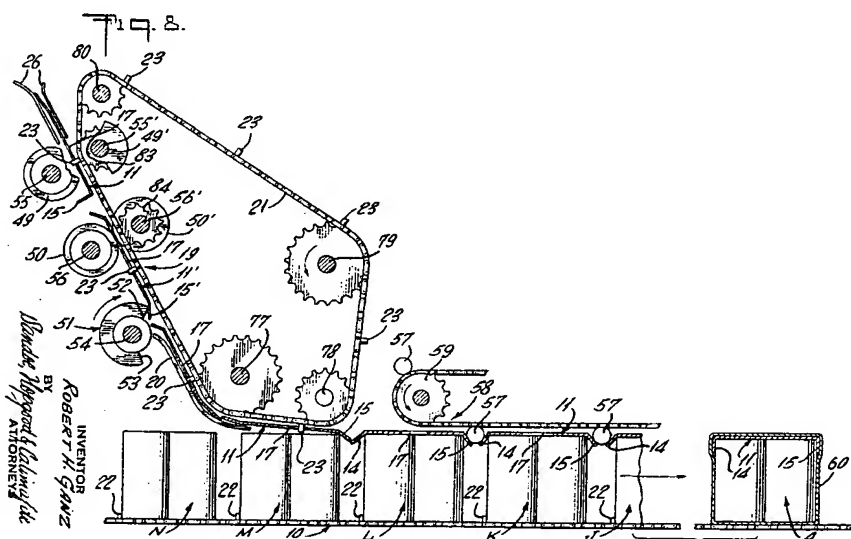
This is a Pre-Appeal Brief Request for Review of the final rejections made in the Office Action of September 5, 2007, submitted concurrently with a timely Notice of Appeal. Upon carefully considering the following comments and arguments of record incorporated herein by reference, Applicant believes the panel during this pre-appeal review will find that the present Examiner committed the following factual and legal errors in rejecting the pending claims.

First of all, the Examiner for the first time in the final Office Action contends that U.S. Patent No. 3,745,892 to Ganz discloses the exact same inventions of claims 1, 2, 5, and 106. In order for these rejections to be sustained, Ganz must expressly or inherently disclose the exact same inventions, arranged precisely as required in these claims. *See Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989) ("The identical invention must be shown in as complete detail as is contained in the...claim."). Moreover, it is axiomatic that "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). The possibility, or even probability, that the claimed structural arrangement exists in a reference is inadequate to meet the "strict identity" requirement for a proper anticipation rejection. *See Continental Can Company USA v. Monsanto Company*, 948 F.2d 1264, 20 USPQ2d 1746 (Fed. Cir. 1991) (holding anticipation "may not be established by probabilities or possibilities").

Claim 1, in pertinent part, requires an overhead lug conveyor for conveying the carton in a first direction, and a takeaway conveyor with an upstanding lug for conveying the carton in a second direction "generally perpendicular" to the first direction. Claim 2 further requires that the lugs are

pivotally mounted to a conveyor chain.

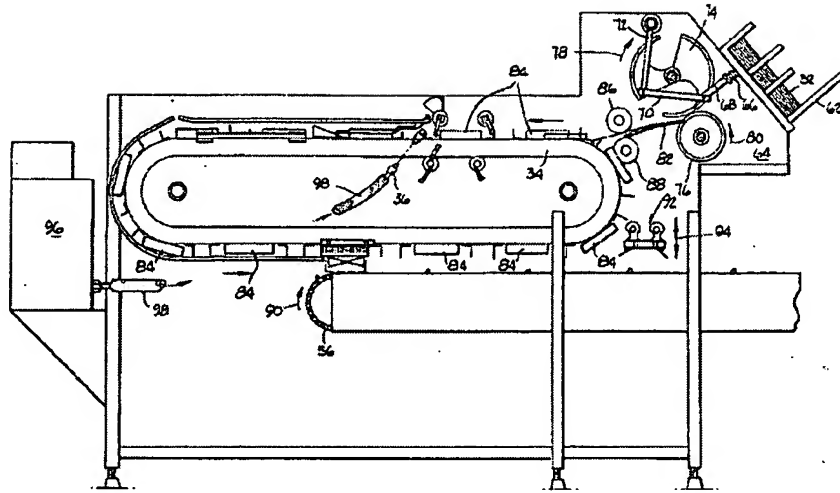
Ganz discloses a first conveyor 10 conveying “clusters” of articles, and a second conveyor 21 that conveys blanks 15 for placement “on the tops of the moving clusters” (col. 3, lines 3-4). As can be readily understood from Figure 8, the respective conveying directions of these conveyors are certainly not “generally perpendicular” to each other:



Reversible error is established in the Examiner’s contention that the lugs 22 are conveyed “in an upstanding position generally perpendicular to conveyor 21,” which is **not** what claim 1 requires.

Moreover, even if it is presumed that the perpendicularity requirement of claim 1 is met, the lugs 22 of the conveyor 10 do not “engage” anything conveyed by the overhead conveyor, as required in claim 1, but rather engage a different structure altogether: namely, the “clusters” (which actually prevent the lugs 22 from engaging the blanks 15). There is also no evidence at all that the lugs 22 or 23 are pivotally mounted to any chain, as required by claim 2 (and the Examiner’s contention that these lugs “move from a depending/engaging position to a retracted/return position” cannot be sustained as meeting this requirement). Accordingly, the Ganz reference does not disclose the “exact same invention” of claims 1 and 2, so the anticipation rejections cannot be sustained.

U.S. Patent No. 4,460,349 to Charron is also relied upon for the first time in the final Office Action as disclosing the exact same invention of claims 1 and 2. Charron discloses a conveyor with “mandrels” 84 that the Examiner contends qualify as lugs, along with a takeaway conveyor 56:



Claim 1 requires that the lug of the overhead conveyor is “selectively movable to a **depending position for engaging and conveying the carton in a first direction** along the path.” Clearly, the first direction of conveyance created by the mandrels 84 when in “a depending position” (as required by the claim) and the second direction of conveyance of the fingers 302 of the takeaway conveyor 56 when in “an upstanding position” (as the claim further requires) are not perpendicular, but rather are **parallel**. In other words, the corresponding first and second directions in Charron are aligned, which is precisely the opposite of what claim 1 expressly requires. Furthermore, the mandrel 84 is not pivotally mounted, as required by claim 2, and the Examiner appears to ignore this requirement in making the anticipation rejection of this claim based on Charron. Accordingly, the reference does not disclose the “exact same invention” of claims 1 and 2, so the anticipation rejections must fall.

In rejecting claims 3-4, the Examiner admits that “the takeaway conveyor of Ganz is not directly disclosed as a pair of chains with lugs, however, it is **likely that the invention was meant to include such a configuration**. . . .” (Office Action, p. 4, ¶ 8) (emphasis added). Respectfully, a rejection based on an unverified statement regarding what an individual Examiner thinks a reference is “likely meant to include” cannot possibly be sustained under the “substantial evidence” standard of the Administrative Procedures Act. *In re Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 (Fed. Cir. 2001) (“[T]he Board [or examiner] must point to some concrete evidence in the record in support of these findings” to satisfy the substantial evidence test).

The Examiner further contends that it would have been an “obvious design choice” to “include two chain conveyors with lugs (configured as the overhead conveyor).” However, such a rejection cannot be sustained here, where the claimed structure and the function it performs (namely, squaring the cartons being conveyed) is different from the prior art. *See In re Gal*, 980 F.2d 717

980 F.2d 717, 25 USPQ2d 1076 (Fed.Cir. 1992) (finding of “obvious design choice” precluded where the claimed structure and the function it performs are different from the prior art).

The Examiner further cites U.S. Patent Nos. 4,590,745 Randles and 2,970,526 to Gobalet to contend that the inventions of claims 1-6 and 9 would be “obvious.” Randles discloses a carton closing machine with bottom-running, fixed lug conveyors 18, 23. No overhead conveyor with lugs selectively movable to a depending position for engaging and conveying a carton is disclosed in Randles. The catches 54 of Gobalet cannot qualify as the claimed lugs of the takeaway conveyor, since these catches remain fixed in place and thus are not conveyed by any conveyor. Accordingly, neither reference teaches or even remotely suggests overhead and takeaway conveyors as claimed with orthogonal conveying directions, and a *prima facie* case of obviousness is lacking for this reason. MPEP § 2143.03 (“To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.”).

As for the combination of Gobalet and Randles, the Examiner states that:

It would have been obvious to one of ordinary skill in the art at the time of the invention to include the overhead conveyor in the invention of Randles for forwarding the boxes along the path.

No “reason” whatsoever is provided for combining the features of these references, which both disclose devices already capable of “forwarding boxes” along a path. Accordingly, a *prima facie* case of obviousness is lacking for this additional reason. *See KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. ____ (2007) (holding that under 35 U.S.C. 103(a), it was “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine . . . elements” and that “**a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art . . .**”) (emphasis added).

Rather than leading a skilled artisan to the claimed inventions, Randles and Gobalet actually teach away from them. Applicant’s claimed carton conveyor advantageously allows for the carton to be conveyed with an overhead lug selectively moved into a position for engaging the carton. This avoids the troublesome “fixed lug” approach of Randles, Gobalet, and others. During high speed operations, fixed lugs have an undesirable tendency to deform the flaps, which may be completely avoided by Applicant’s claimed invention.

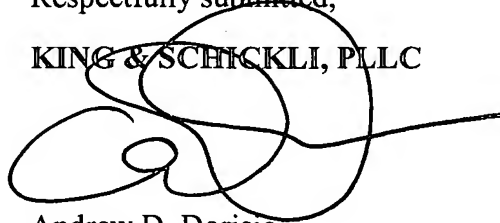
Furthermore, Applicant couples the advantages of the overhead conveyor having a depending

lug with an orthogonal takeaway conveyor having upstanding lugs. This advantageously provides a much smaller footprint while maintaining the desirable high throughput, and without the need for uncontrolled transfer of the carton between two bottom-running, orthogonal conveyors (which, by their very nature, cannot overlap). Neither Gobalet nor Randles even remotely suggest this combination of features, or otherwise provide the concomitant advantages afforded by Applicant's claimed inventions. Instead, Gobalet merely discloses a single lug conveyor, and Randles teaches two bottom-running lug conveyors. These references thus not only represent the *status quo*, but would also actually tend to lead a skilled artisan in a divergent direction from the path taken by the present Applicant. *See, e.g. In re Gurley*, 27 F.3d 551, 553, 31 USPQ2d 1130 (Fed. Cir. 1994) ("A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be . . . led in a direction divergent from the path that was taken by the applicant."). Accordingly, the cited references are considered inapposite in the obviousness calculus.

In summary, Applicant has identified errors that it is believed would lead to a reversal of all extant rejections on appeal. Upon careful review and consideration, it is believed the panel will agree that the Examiner has committed the foregoing reversible errors and find the inventions of all claims patentable over the cited prior art. In the event any additional fee is due for processing this Request document or otherwise, please debit it from Deposit Account No. 11-0978.

Respectfully submitted,

KING & SCHICKLI, PLLC

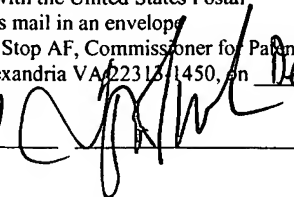


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12/5/07  December 5, 2007